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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,805	04/20/2001	David A. Hughes	SNY-P4352	3515

24337 7590 02/18/2004

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EXAMINER	
JAKETIC, BRYAN J	

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/838,805	Applicant(s) HUGHES ET AL.	
	Examiner Bryan Jaketic	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 April 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4,5*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claim 36 recites the limitation "the entertainment content" in line 6 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 2, 4-14, and 28-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,670,537 B2 (hereafter "'537"). Although the conflicting claims are not identical, they are not patentably distinct from each other because '537 claims the steps

of receiving an electronic sample (see claim 1); receiving a link to a source of purchase of a complete copy, using the link to connect to the source, and purchasing the complete copy (see claim 6). '537 also claims that the sample is received as an email attachment (see claim 1). '537 also claims that the sender receives an affinity credit (see claim 7). '537 also claims that the sample comprises a file of a compressed content sample (see claim 12). '537 also claims that the sample comprises a link to a source of streaming music, which is a source of purchase (see claims 5 and 6).

'537 does not claim that the link comprises a URL. However, it is common in the art for links to comprise a URL, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a link comprising a URL, because a URL is the easiest means to create a link.

'537 does not claim an electronic file transfer. However, delivery of content via electronic file transfer is common in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of delivering the content via an electronic file transfer because EFT is a quick and efficient means of delivering electronic data.

5. Claims 3 and 15-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,670,537 B2 (hereafter "'537") in view of Hurtado et al. '537 claims all of the limitations as discussed in paragraph 4 of this Office Action. '537 does not claim that the sample includes an encrypted copy of the content, wherein the complete copy is purchased by decrypting the encrypted copy. Hurtado teaches a method of

distributing music, wherein the user receives an electronic sample of music comprising an encrypted copy of the complete work (see col. 83, lines 45-67). Hurtado further teaches that the user purchases the complete copy by decrypting the encrypted copy (see col. 84, lines 1-17). Hurtado further teaches that the electronic sample package may be emailed to the user (see col. 87, lines 1-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Hurtado with the claims of '537 to provide an encrypted copy of the content to the user with the sample so that the user won't have to wait for a long download at the time of purchase.

'537 does not claim, and Hurtado does not discuss the step of unlocking the music selection for a limited number of plays. However, it is common in the art to limit the number of plays of a file, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of unlocking the music selection for a limited number of plays to generate additional revenue for additional plays.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

> only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 6, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Fritsch. Fritsch discloses a method of purchasing electronic entertainment content comprising: receiving an electronic sample of the content comprising a link to a source of streaming music, receiving a link to a source of purchase of the complete copy, using the link to connect the source of purchase, and purchasing the complete copy (see col. 4, line 47 through col. 5, line 9). The link to the source of purchase is a link to a web site, and it is therefore inherent that the link comprises a URL. Fritsch teaches that the music is delivered immediately over the Internet (see col. 4, lines 1-9). It is therefore inherent that an electronic file transfer occurs.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fritsch. Fritsch does not teach that the file contains a compressed content sample. However, it is common in the art to compress files and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a compressed file with the invention of Fritsch to allow for easier transfer of the file.

11. Claims 3, 22, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fritsch in view of Hurtado et al. Fritsch teaches all of the limitations discussed in paragraph 7 of this Office Action. Fritsch does not teach the step of including an encrypted copy of the content. Hurtado teaches a method of distributing music, wherein the user receives an electronic sample of music comprising an encrypted copy of the complete work (see col. 83, lines 45-67). Hurtado further teaches that the user purchases the complete copy by decrypting the encrypted copy (see col. 84, lines 1-17). Hurtado further teaches that the electronic sample package may be emailed to the user (see col. 87, lines 1-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Hurtado with the invention of Fritsch to provide an encrypted copy of the content to the user with the sample so that the user won't have to wait for a long download at the time of purchase.

12. Claims 4, 5, 9-14, and 28-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fritsch in view of kang (US 2001/0051925 A1 from IDS of April

2003). Fritsch discloses all of the limitations discussed in paragraph 7 of this Office Action. Fritsch does not teach the steps of attaching a sample to an email message or crediting an affinity credit to the sender. Kang teaches the step of distributing music as an email attachment (see p.2, paragraph 29) and the step of crediting an affinity credit to the sender (see paragraph 30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of kang with the invention of Fritsch to send music attachments via email and credit senders in order to provide rapid and wide distribution of the content.

13. Claims 15-21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fritsch and kang as applied to claims 4, 5, and 9-14 above, and further in view of Hurtado et al. The combination of Fritsch and kang teaches all of the limitations discussed in paragraph 13 of this Office Action. Fritsch and kang do not teach the step of sending an encrypted version of the music selection. Hurtado teaches a method of distributing music, wherein the user receives an electronic sample of music comprising an encrypted copy of the complete work (see col. 83, lines 45-67). Hurtado further teaches that the user purchases the complete copy by decrypting the encrypted copy (see col. 84, lines 1-17). Hurtado further teaches that the electronic sample package may be emailed to the user (see col. 87, lines 1-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Hurtado with the combination of Fritsch and kang to provide an encrypted copy of the content to the user with the sample so that the user won't have to wait for a long download at the time of purchase.

The combination of Fritsch and kang does not teach, and Hurtado does not discuss the step of unlocking the music selection for a limited number of plays. However, it is common in the art to limit the number of plays of a file, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of unlocking the music selection for a limited number of plays to generate additional revenue for additional plays.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shoff et al, Spagna et al, Bernard et al, Ronning, and Eller et al disclose music distribution systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Jaketic whose telephone number is (703) 308-0134. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703)308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bj

2/13/04